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EXAMINER

RETTA YEHDEGA

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,295

Applicant(s)

MORRISROE ET AL.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 2/5/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to the Request for continued Examination, filed January 29, 2008. Applicant amended claim 1. Claims 1-28 and 31-33 are still pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "combining an ad input file with a conduit file to create an integrated ad file containing both the ad input file and the conduit file contents, wherein the ad input file identifies the content of the ad and the conduit file comprises computer code to provide the ad and to identify tracking data for the ad".

The specification however teaches as follows:

FIG. 2 illustrates the general operation of the present embodiment in which a user 112 accesses a web page, for example, the portal's home page provided by web server 106 or another page provided by a web server 114. The web page includes html code (ad.html) 202 for loading an integrated ad file 204 from the ad server 102. As will be described in greater detail below, the integrated ad file 204 reflects the integration or combination of two separate files: an ad input file, primarily including the contents of the ad, and a conduit file, primarily including code used in tracking the ad. Because Macromedia Flash is used in the present embodiment, the files have ".swf" extensions; thus, the integrated ad file is generically referred to as "ad_done.swf"; the electronic ad input file 504 submitted by the Advertiser 110 is generically referred to as "ad_input.swf"; and the conduit file created by the portal 100 is generically referred to as "conduit.swf." (see [0028])

FIG. 5 illustrates operations performed by the portal 100 (e.g., an administrator 108) in creating the integrated ad file 204 to be served via the ad server 102. As illustrated, the portal 100 uses a merge tool 502 to combine the contents of an ad input file 504 provided by the Advertiser 110 with the contents of a conduit file 506 created by the portal 100. In general, the ad input file 504 contains the content of the ad, as provided by the advertiser, and the conduit file 506 contains code for tracking the ad. (see [0038])

[0039] The merge tool 502 of the present embodiment is an executable program that combines the content of the ad file 504 with the contents of the conduit file 506 to create an integrated ad file 204 ("ad_done.swf"). The merge tool 502 may take any number of forms, may have any number of different user interfaces, and may be written in any number of languages, including C++, Java, Perl, and the like. As such, the merge tool make take the form of a web-based application accessible via an Internet Web page. (see [0039])

As disclosed, in Applicant disclosure, an integrated ad file is creating to be served via an ad server. A merge tool is used to combine contents of an ad input file provided by an Advertiser with contents of a conduit file created by a portal. The ad input file includes the content of ad and the conduit file includes codes used for tracking the ad. The merge tool (an executable program) combines the content of the ad file with the contents of the conduit file to create the integrated ad file.

The specification however does not disclose "combining an ad input file with a conduit file to create an integrated ad file containing both the ad input file and the conduit file contents, wherein the ad input file identifies the content of the ad and the conduit file comprises computer code to provide the ad and to identify tracking data for the ad."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by of Solbright White Paper; "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright).

Regarding claim 1, Solbright teach integrating an input file (Flash ad) and conduit file (tracking code) and creating an integrated file *containing both the ad input file and the conduit file; wherein the conduit file comprises of computer code for tracking data for the ad*, and serving the integrated ad file from a computer to provide the ad (see pp 17-19);

Regarding claim 4, Solbright teaches the use of Macromedia Flash; wherein the ad is Flash ad and the files are “swf” files (see pp 17 see also the sites for the “Macromedia’s Rich Media Tracking Kit” cited in White Paper, page 17)).

Regarding claims 7-10, Solbright teaches the ad including one or more actions for linking to one or more web pages where in the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 18-20, see also www.macromedia.com/solutions/richmedia/tracking/advertising_guide/).

Regarding claim 33, Solbright teaches the ad is provided to a user computer via the Internet and combining of the files is in response to receiving a request for a Web page and serving the integrated ad file as par of the web page (see pp 17-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 11-28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solbright White Paper, "The Inside Edge on Rich Media Partnership Series"; March 2001, (herein after Solbright) in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, Solbright does not explicitly teach receiving a modified ad file or conduit file. Solbright teaches designers creating their ads and developers or programmers adding the tracking string after the ads are created. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 5 and 6, Solbright does not explicitly teaches the input file includes an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name. However official notice is taken that well known in the art of movie clip create empty movie clip and to assign a predetermined name. It is well known to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 11, 12, 15-21, 24-27, Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for

providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that is old and well known in the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking data to be inserted in it, if the ad is a movie clip.

Regarding claims 31 and 32, Solbright teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 17-20).

Response to Arguments

Applicant's arguments filed January 29, 2008 have been fully considered but they are not persuasive.

Applicant again argues that it is clear that Solbright suffers from the same conventional shortcomings described in the background of the present application and discussed above. Applicant argues in order to track an ad, for each Flash ad file, Solbright's approach requires that a programmer edit the file to include the getURL action code to the Flash ad file and if a change needs to be made to the action code, or a new Flash ad file is created, additional programming

effort is needed to edit Solbright's Flash ad file. Applicant also asserts that Solbright's HTML wrapper file is never combined with an ad input file to create an integrated ad file. Solbright's HTML wrapper file and ad file are discrete files that must be served separately. Furthermore, Applicant asserts that Solbright's parameter passing, which passes a value from the HTML file to Solbright's ad file, occurs at the client computer after the HTML file and the ad file have been served, after the ad is displayed in a browser window of the user's computer, and the user interacts with a button displayed in the browser window to provide button input in connection with the displayed ad. Solbright never combines its HTML file and its ad file, and in fact never combines its ad file with any other file to create an integrated ad file. The Examiner does not understand how applicant came up with that conclusion. Solbright teaches that the biggest barrier to the adoption of rich media technologies like Macromedia Flash has been confusion about how to incorporate performance tracking within **uneditable compiled file** ... until now, advertisers and web publishers followed laborious and costly processes for each ad placement to get the correcting string inserted. Solbright teaches to ease the burden of this process the MFAA advises developers to **create an editable HTML wrapper** for the ad that uses ... (see page 17). Solbright also teaches creating **an HTML wrapper file** that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad. Solbright teaches each publisher will need to modify this file to insert their own, unique tracking code. This file should also have the appropriate sniffer code to detect the presence of the Macromedia Flash Player, and to display the alternate GIF ad if necessary. Examiner would like to point out that the article is referring to the HTML wrapper file being modified not the Flash ad file. Solbright also shows a brief explanation of the <EMBED> string (tracking string syntax) as

("EMBED SRC="/imageserver/banner.swf?clickTAG=http://adserver.com/trackingstring?http://www.advertiser.com/destination.html"). Further Solbright teaches that are a number of parts to this embedded tracking string; the first part of the tracking string /imageserver/banner.swf is used to identify the location of the Macromedia Flash file on the publisher's image server (*the advertiser will not know this string in advance*), the variable (clickTAG) is used to identify the tracking location (http://adserver.com.trackingstring) on the publisher server that will log the number of clicks on the ad. (see page 18).

Applicant keep arguing that while the Examiner contends that "tracking code" corresponds to the claimed conduit file, as is clear from the concessions made by the Examiner in the Office Action discussed above, tracking code *per se* cannot and does not disclose or even suggest a conduit file, let alone a conduit file which is combined with an ad input file to create an integrated ad file as is recited in Claim 1. Examiner would like to point out that, according to applicant's disclosure the conduit file "primarily includes code used in tracking the ad". If applicant is claiming that the conduit file is more than the code used for tracking the ad, Applicant's specification does not clearly teach such feature. According to applicant's invention the advertiser creates the content of the ad (504), and the portal uses the merge tool 502 to combine the content of ad input file (provided by the Advertiser) and conduit file (tracking code created by the portal). Therefore, the tracking code are created and added to the ad file at the server, same as the prior art; the same as creating an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the

ad and then each publisher will need to modify this file (wrapper file) to insert their own, unique tracking code (same as applicant merge file to add the tracking code (conduit file)).

In respond to the argument regarding claim 2, since Solbright teaches the ad file is provided by the advertiser and the publisher creates the integrated file any modified ad or replacement ad would be provided by the advertiser and the publisher would insert the tracking code or different code based on the tracking requirement. Applicant states "(t)o the extent that the Examiner is relying on "Officially Noticed" facts, the Applicant hereby traverses such Official Notice based at least on the above discussion and the concessions made in the Office Action, and specifically requests the Examiner to provide documentary evidence of any such "Officially Noticed" facts, should the Examiner maintain the rejection". Applicant's attempt to challenge the examiner's taking of Official Notice are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official notice. Applicant has not provided adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Allowing bald statements such as " requesting the Examiner to provide documentary evidence of any official noticed" to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection of a well known facts. Therefor, the presentation of a reference to substantiate the Official Notice is not deemed necessary and the examiner's taking of the Official notice has been maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622